

APPLICANT'S REMARKS

That claims 1-15 are allowable is gratefully acknowledged.

Claims 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutter (U.S. Patent 6,662,751) in view of Flem (U.S. Patent 5,145,265).

The examiner admits that "Rutter does not disclose bushing means disposed between the connector portion and the receiver portion." The examiner does not acknowledge that Rutter does not disclose or even recognize the problem addressed by Applicant.

To fulfill Rutter's failure to disclose a "bushing means," he cites Flem that "teaches a bushing means 2 in the analogous art of bearings for the purpose of 'popping' the bearing 'in' a desire bore 40, and subsequently providing a wear surface for a shaft 50." He also cites Snow (U.S. Patent 1,849,963) as another example of an adjustable bearing that he ostensibly believes could be used in the Rutter structure.

Regarding the language of currently amended claim 16, the examiner states that it "would have been obvious to one of ordinary skill in the art to include the split as taught by Flem in order to cylindrically expand and resiliently grasp the connector portion." Yet Flem splits his bearing so that there is room for it to contract and resiliently expand outwardly to butt against the inner wall of the bore. This function is just the opposite from that which now limits claim 16. If the ordinary skilled artisan were to do what the examiner says he is lead to do, he would destroy the Flem structure that would no longer function as disclosed.

The examiner concludes that it would be "obvious to one of ordinary skill in the art at the time the invention was made to modify Rutter to include a bushing means as taught by Flem in order to minimize wear and tear on both the connector portion and the receiver portion."

Applicant's Invention

In contrast to Rutter, Applicant recognizes the novel rattling problem associated with this type of tether assembly, and solves the problem by making a bushing that springs inwardly to thus resiliently grip and rotate with the connector portion disposed within the receiver portion as set forth in Applicant's claims. Applicant's connector portion does not continuously rotate 360° within his receiver portion so that there is no generation of heat problem. Applicant's bushing means resiliently grasps the connector portion to prevent the rattling noise and allows his connector portion to quietly and smoothly be disposed in and rotate with respect to his receiver portion.

Argument

The examiner refers to "the analogous art of bearings" to justify the combination of Flem with Rutter for the purpose of "'popping' the bearing 'in' a desired bore 40, and subsequently providing a wear surface for a shaft 50." Rutter does not disclose a rotating shaft that would cause a heat problem as solved in the "bearing art." Both Flem and Snow disclose bearings that spring outwardly so as to "pop" into the bore and not rotate with the respectively disclosed shafts so as to solve a heat problem between moving parts.

Applicant deals with a problem in the tether assembly art and not in the mechanical bearing art. Applicant solved a problem that is not even recognized in the primary reference of Rutter by using bushing means that springs inwardly and resiliently grasps his connector portion to prevent the rattling noise problem and allows his connector portion to operate quietly and smoothly. Because Rutter deals with the tether assembly art and Flem and Snow deal with the mechanical bearing art for solving rotational heat problems, the references constitute non-

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analogous prior art and cannot be combined.

NON-ANALOGOUS PRIOR ART:

The examiner must determine what is “analogous prior art” for the purpose of analyzing the obviousness of the subject matter at issue. To rely on a reference as a basis for rejection of an invention, the reference must either be in the field of applicant’s endeavor (the tether assembly field) or, if not, then be reasonably pertinent to the particular problem (a rattling problem in the tether assembly field) with which the inventor is concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993)>; and *State Contracting & Eng’g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). An outwardly springing, split bearing (Flem) is not analogous to an inwardly springing, split bearing (Applicant) to solve a problem *not* disclosed by Rutter.

Non-analogous Prior Art References

Rutter’s connector does not continuously rotate 360° within its receiver portion and he

does not recognize the rattling problem so he makes no attempt to solve one. He has no heat and/or wear problem such as that found in the Flem and Snow references. Flem and Snow actually teach away from Applicant's claimed invention because the Flem and Snow rotating shafts rotate within their respective bushings that spring outwardly to be non-rotatable within the respective cylindrical receiver portions.

Flem and Snow are outside the pertinent field of endeavor of Rutter and Applicant's invention. So the references may be considered analogous art only if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved. Applicant's invention addresses a mere rattling problem not recognized by Rutter. Flem and Snow address a heat generation and/or wear problem of a rotating shaft that rotates within the bushing that is unrelated to Applicant's problem. Flem and Snow are clearly outside the pertinent field of endeavor of Rutter and cannot be combined to reject claims 16-18 and 20 under 35 U.S.C. 103(a).

Rutter is associated with the tether assembly art. Rutter does not recognize the problem of noise due to the back and forth, rattling movement of the connector portion within the connector receiver portion. Rutter's connector portion does not continuously rotate 360° within his connector receiver portion.

Flem is associated with the pop-in bearing art that facilitates a decrease (a) in wear of the rotationally moving shaft within a stationary workpiece, and (b) in the amount of friction that causes an additional generation of heat by the rotation of a shaft in the workpiece. Flem's bushing springs outwardly circumferentially inside the bore so that it does **not** rotate with the

rotating shaft.

Snow is in the adjustable bearing art having a mechanical clamp for reducing the circumference of a split, outwardly springing bushing around a rotatable shaft after wear occurs due to their relative rotation. That is, the Snow bushing does *not* rotate with the rotating shaft.

Neither Flem nor Snow deal with subject matter that is not reasonably pertinent to the particular rattling problem in the tether assembly field with which Applicant is concerned. For the subject matter with which these secondary references deal logically would *not* have commended itself to Applicant's attention in considering his problem. For these reasons, Flem and Rutter do not constitute analogous art that may be combined to preclude patentability of Applicant's amended claims 16-18 and 20.

COMBINING REFERENCES:

To establish prima facie obviousness, the cited prior art must suggest the desirability of the combination of the Rutter and Flem references. No suggestion of desirability to combined the references exists, and the § 103 rejection merely combines and modifies the references to fit Applicant's claims after the examiner has gleaned knowledge of Applicant's claimed invention. That is, in any rejection of claims over a combination of references, the examiner must show some teaching that the references must include some reason to combine the references, other than the applicant's disclosure in his own application.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)

(The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In the instant case, the references on which the examiner relies do not teach the problem in the tether assembly art and the secondary references do not teach bushing means that grasp the rotatable connector portion. Clearly the references do not teach every element that is being claimed, and no reason exists for the combination of references. So without a motivation to combine the cited references, a rejection based on a *prima facie* case of obvious is improper.

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In*

re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

No Obviousness in Combination of References

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. As shown, no such teaching, suggestion, or motivation is found in the Rutter and Flem references.

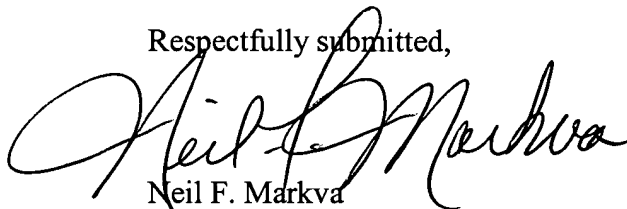
As shown, the combination of references does not teach every element of Applicant's invention, but actually teaches away from it. Without a motivation to combine the cited references, and even if the combination of references were appropriate, it would still not teach the invention as claimed. Therefore, a rejection based on a *prima facie* case of obvious is improper.

The examiner has not shown any teaching in the references that discloses a reason to combine the references, other than the applicant inventor's disclosure in his own application. And even if some reason were found, the combined teachings of the references would have suggested to those of ordinary skill in the art to use a bushing means that springs outwardly with respect to a connector portion that rotates therein. This is not what is being claimed.

Conclusion

In view of the foregoing, the references do not constitute analogous prior art, and there is no evidence of record of any teaching in the references to suggest to one having ordinary skill in the art to effect the structure of claims 16-18 and 20. For these reasons, early allowance of claims 16-18 and 20 is respectfully requested.

Respectfully submitted,



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